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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/015,303	12/12/2001	Michael D. Hooven	HOOV 116	9423

26568 7590 11/20/2002

COOK, ALEX, MCFARRON, MANZO, CUMMINGS & MEHLER LTD  
SUITE 2850  
200 WEST ADAMS STREET  
CHICAGO, IL 60606

EXAMINER

KEARNEY, ROSILAND STACIE

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 11/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/015,303

Applicant(s)

HOOVEN, MICHAEL D.

Examiner

Rosiland S Kearney

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **Recent Statutory Changes to 35 U.S.C. § 102(e)**

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

**A person shall be entitled to a patent unless –**

**(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at [www.uspto.gov](http://www.uspto.gov) or call the Office of Patent Legal Administration at (703) 305-1622.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

**{SEE ATTACHMENT}**

Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Burnside et al. '281.

Burnside et al. disclose a device for clamping and ablating cardiac tissue comprising a first handle member (400), a second handle member (402), first and second mating jaw members (382, 384), the jaw members having insulated outer surfaces (col. 47 lines 18-23) with convex opposed mating surfaces (figure 80), each mating surface having a central peak as illustrated in figure 80, a first and second elongate electrode (294; col. 45 lines 61-68) and at least one thermocouple (col. 32 lines 60-65).

Claim 4 is rejected under 35 U.S.C. 102(e) as being anticipated by Koblish et al. '700. In figure 21, Koblish et al. disclose a tissue grasping apparatus comprising first and second grasping jaws (160, 162), each jaw including a raised electrode (20) and a receding clamping surface, the clamping surfaces comprising an insulating material (col. 17 lines 12-17) and a thermocouple on the clamping surface (col. 14 lines 5 – 19).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burnside et al. '281 further in view of Imran '860.

Burnside et al. teach all of the limitations of the claims except the electrodes comprising gold plated copper and the length and width of the electrodes.

Imran discloses an ablation device and teaches that it is old and well known in the art to use gold plated copper as an electrode material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select gold plated copper as the electrode material for the Burnside et al. device, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, particularly in view of the teaching of Imran.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the electrode according to the dimensions as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum dimensions involves only routine skill in the art.

Art Unit: 3739

Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koblish et al. '700 further in view of Imran '860.

Koblish et al. teach all of the limitations of the claims except the electrodes comprising gold plated copper and the length and width of the electrodes.

Imran discloses an ablation device and teaches that it is old and well known in the art to use gold plated copper as an electrode material. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select gold plated copper as the electrode material for the Koblish et al. device, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice, particularly in view of the teaching of Imran.

Furthermore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to form the electrode according to the dimensions as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum dimensions involves only routine skill in the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosiland S Kearney whose telephone number is 703/3082711. The examiner can normally be reached on Mon.-Fri. 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C. Dvorak can be reached on 703/3080994. The fax phone numbers

Application/Control Number: 10/015,303

Page 5

Art Unit: 3739

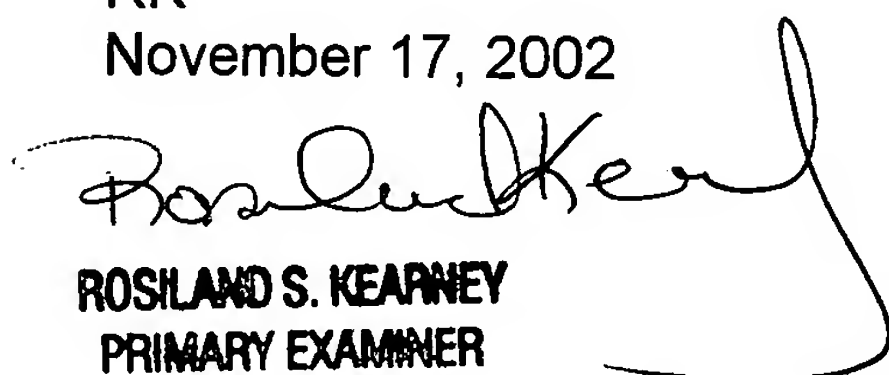
for the organization where this application or proceeding is assigned are 703/3080758

for regular communications and 703/3080758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703/3080858.

RK

November 17, 2002

A handwritten signature in black ink, appearing to read "Rosiland S. Kearney", with a long, sweeping horizontal stroke extending to the right.

**ROSILAND S. KEARNEY**  
**PRIMARY EXAMINER**